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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,309	03/29/2004	Cory Richardson	3691-666	8273
23117 7590 12/30/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER LAZORCIC, JASON L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,309

Applicant(s)

RICHARDSON ET AL.

Examiner

JASON L. LAZORCIK

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 12-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Applicants reply dated September 4, 2009 amends claim 1 and 12. All other claims stand as presented in the reply dated April 3, 2009.

In view of the instant reply, claims 8-11 and 18-20 stand as having been cancelled by Applicant and no claims have been withdrawn from consideration. Therefore, Claims 1-7, 12-18, and 21-23 are pending for prosecution on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7, 12-18, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stachowiak (US 6,602,608) in view of Medwick (US 6,682,773) and Konda (US 5,254,201).

Stachowiak teaches a multi-layered low-E reflective film (Table 1, Figure 1) comprising at least one infrared reflecting layer with silver "sandwiched" between at least a first and second dielectric layer. The reference teaches that the layers are deposited by a sputter coating process (Column 5, lines 57-67), that the uppermost layer of the coating comprises Silicon Nitride, that it is known to heat treat said coated articles (e.g., thermally temper, heat bend or the like) (column 2, Lines 58-63), and finally to incorporate said sheets into "architectural windows (e.g. IG units)". The instant reference clearly indicates that the disclosed thin film structure will have a transmission of at least 65% through at least 80% on occasion (Column 6, Lines 51-53). Stachowiak is silent regarding the subsequent processing of the Low-E glass sheet after thin film deposition or regarding the application of a removable, protective coating to the substrate.

In accord with applicants disclosed (prior art) figure 1, it is also understood to be well known and established in the art to coat the Low-E glass substrate with a protective film and to subsequently cut, edge seam, and wash the coated substrate. This assertion is corroborated by the teachings set forth by Medwick (US 6,682,773) which indicates that "for substrates with one or more functional coatings (e.g. a functional coating on the first surface) the protective coating is preferably deposited over at least a portion of the functional coating(s) to protect the functional coating(s) from mechanical

and/or chemical damage and/or misidentification during shipment, storage, handling, and processing" (Column 3, Lines 15-21). The reference continues by specifically citing the need to protect the functional coating on Insulated Glass (IG) units from marring or damage during processing, shipment or storage (column 1, Lines 40-45). Finally, the instant reference teaches that it is beneficial to alter the color of the coating in any manner deemed appropriate to clearly and easily identify the nature of the coating on the glass substrate (including altering the coating to a green tint) (Column 12, Lines 6-55). By applicants admitted prior art and the teachings set forth by Medwick, it would have been obvious to one of ordinary skill in the art to apply a protective film to the IG substrate prior to cutting, edge seaming, and washing said substrate in order to appropriately protect the functional surface from damage or marring. The combined Medwick and Stachowiak still fail to explicitly set forth the application of a flexible solid film comprising polyethylene with an adhesive layer comprising acrylic as the protective film.

Konda (US 5,254,201) teaches that a preformed and solid protective sheet having excellent water resistance can be made from polyethylene (column 3, Lines 21-28) with a pressure-sensitive adhesive layer of an acrylic type (Column 3, Line 46). The instant reference continues by disclosing the application of this protective sheet to a semiconductor wafer to prevent damage to the thin film circuit pattern printed on the surface thereof during grinding and/or polishing procedures performed on the wafer (Column 1, Lines 15-58). It further indicates that when the presence of the film is no longer deemed necessary, it can be directly stripped from the surface of the substrate

either by hand or machine. The immediate reference is considered to be analogous prior art for the claimed subject matter since the disclosed film is applied to a substrate in such a manner to protect the fine structure of a film formed thereon from damage or marring. It would therefore have been obvious to one of ordinary skill in the art of thin film processing to utilize the solid film set forth by Konda as the protective film collectively taught by the Medwick and Stachowiak references. This would be an obvious substitution for the Medwick film taught above since the pressure sensitive adhesive in the Konda film allows simple removal of the film by machine or by hand when its presence is no longer required.

(I) The prior art is silent regarding a flexible protective sheet having a thickness of 1mm to 3mm

Applicant acknowledges that Konda teaches use of a flexible protective sheet having a thickness of 20 to 200 micrometers (see Applicants reply, page 10) and that Medwick teaches protective film thicknesses of 1 to 250 micrometers (see Applicants reply, page 9), however the prior art of record is silent regarding a flexible protective sheet having a thickness in the range of 1 mm to 3 mm as recited in independent claims 1 and 12

(II) Applicants disclosed protective sheet thickness is encompassed by Konda and Medwick and the recited sheet thickness would have been obvious in view of the ordinary level of skill in the art at the time of the invention.

1. For reasons noted above in the rejection of claims under 35 U.S.C. §112, first paragraph, Applicants protective sheet thickness range is construed to be limited to a thickness of 1 to 3 Mills or ~ 25.4 to ~76.2 microns in thickness which is clearly consistent both with Applicants original disclosure and Applicants preferred embodiments as noted above. The sheet thickness ranges disclosed by both the Konda and Medwick references wholly encompass Applicants disclosed thickness ranges as well as the sheet thickness of Applicants preferred embodiment.
2. Further, one of ordinary skill in the art at the time of the invention would have viewed the use of a thicker protective film as a merely routine and obvious extension over the prior art teachings. That is, one having no more than a rudimentary level of skill in the art at the time of the invention would recognize that increasing the thickness of the protective sheet used would predictably enhance the scratch resistance of the underlying substrate during handling. Absent compelling evidence of unexpected results, it is the Examiners assessment specification of an appropriate protective film thickness would have fallen well within the purview of a skilled technician that that use of a thicker protective film within Applicants recited range would have yielded a wholly predictable increase in scratch resistance for the substrate.
3. It is therefore the Examiners assessment that the use of a protective film having a thickness in the range of 1000 to 3000 microns is insufficient to patentably distinguish the recited invention over that disclosed in the collective prior art.

Regarding Applicants newly submitted claims 21 and 22, none of the cited prior art references explicitly limit the substrate temperature to fall between 60-120°C or 90-120°C as required in the respectively identified claims. With this point in mind, it is the Examiners position that the claimed temperature ranges are insufficient to patentably distinguish the claimed invention over that set forth in the collective prior art.

Applicant's specification indicates that the claimed temperature range naturally flows from the deposition of the Low-E coating process (paragraph [0038], pages 10-11). One of ordinary skill in the art at the time of the invention would have recognized the benefit to applying the protective sheet in as expedient a timeframe as possible after formation of the Low-E coating, namely as a means to minimize the potential for surface contamination. The skilled practitioner would have likewise been well aware that application of the protective sheet on a substrate of too high a temperature would result in potentially irreversible damage to either the organic adhesive and/or polyethylene backing sheet. In view of the foregoing and absent any evidence of unexpected results to the contrary, it is the Examiners position that the claimed substrate temperature ranges would have been derived by the skilled practitioner through no more than routine experimentation and optimization of the prior art disclosed process.

Response to Arguments

Applicant's arguments filed September 4, 2009 have been fully considered but they are not persuasive.

Argument #1)

Applicant alleges that Medwick teaches away from modification in view of Konda. Specifically, Applicant alleges that Medwick requires the protective coating to be very thin in order to retain the ability to cut the substrate into smaller pieces. In support of this position, Applicant points to the narrowest preferred film thickness range disclosed in Medwick as well as an exemplary embodiment which recites thickness values in the range from 7 and 10 microns. Applicant notes that Konda teaches film thickness ranges between 25 and 250 microns and thereby concludes that the films in the Konda thickness range would have an adverse effect upon the cutting the Medwick substrate and that one of ordinary skill would therefore never consider substitution of the Konda film for the Medwick film.

In response, Applicant preliminarily advised that Medwick teaches preferred film thickness ranges up to 1000microns in thickness (col. 10, lines 22-42) which encompasses the Konda film thickness range. On this point alone, Applicants argument is deemed wholly unpersuasive.

Further, Applicant is respectfully advised that Medwick nowhere discloses nor suggests what threshold thickness covering would be construed as "too thick". It follows that Applicants allegation that a protective film having a thickness as set forth Konda would adversely affect the cutting process is in no manner supported either by the prior art disclosures no by any persuasive evidence on the record. Applicants arguments on this matter are therefore construed as unsubstantiated attorney argument.

Argument #2

Applicant alleges that the Konda film does not solve any of the problems discussed in Medwick with respect to peelable protective coatings. Specifically, Applicant alleges that Konda does not solve the deficiencies of Medwick including "pieces being left behind, and a question of what to do with the waste material". Applicant further alleges that Konda does not solve any of the problems that Medwick describes as the negative effects of peelable protective coatings.

In response, Applicant is preliminarily advised that solving any and/or all of the prior art recognized deficiencies such as those briefly mentioned in the background of the Medwick reference is in no manner a prerequisite to establish a prima facie case of obviousness. With respect to this matter, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Applicant was advised that a skilled practitioner would look to the Konda protective film since this reference explicitly teaches that the inventive film allows simple removal of the film by machine or by hand when its presence is no longer

required. In addition, Applicant was previously advised that both Medwick and Konda share a common goal, namely to prevent the marring of a delicate thin film structure on a refractory substrate. Applicant was further advised that one having no more than an ordinary level of skill would recognize the applicability of Konda film protecting the Low E coatings of the Stachowiak and Medwick references.

The foregoing points notwithstanding, the Examiner does not agree with Applicants assertion that the Konda protective film "does not solve *any* of the problems that Medwick describes as the negative effects of peelable protective coatings" (emphasis added). Specifically, Medwick teaches that a principle detraction with the peelable coating disclosed in FR 2,295,100 and relied upon to support Applicants argument is cast from a liquid state and requires that "a large amount of organic solvent must be reclaimed, recycled, or disposed of after being used in the deposition of the peelable protective coating" (see Medwick col. 2, lines 17-21). Since Konda teaches adhesion of a previously formed, solid protective coating upon the target substrate as opposed to casting said protective film from a solution, it would appear self evident that the Medwick noted problem with organic solvents would be circumvented through the use of the Konda protective film.

For at least the above noted reasons, Applicants arguments suggesting that one of ordinary skill would not combine the Konda and Medwick references are deemed unpersuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. LAZORCIK whose telephone number is (571)272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason L Lazorcik/
Primary Examiner, Art Unit 1791